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TR

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/816,626 03/23/01 BOUVE

W 387968

EXAMINER

TM02/1022

LATHROP & GAGE, LC  
SUITE 302  
4845 PEARL EAST CIRCLE  
BOULDER CO 80301

ALAM, H

ART UNIT

PAPER NUMBER

2172  
DATE MAILED:

2  
10/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

SM

**Office Action Summary**

Application No.

09/816,626

Applicant(s)

BOUVE ET AL.

Examiner

Hosain T Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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### DETAILED ACTION

Claims 1-63 are pending in this Office Action.

#### *Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 5,682,525 issued to Bouve et al. ("the '525 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set forth hereinbelow.

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Claims 1-63 are essentially the same as claims 1-35 except that they recite "geographical position" instead of "geographical positional coordinates."

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use coordinates to point to geographical locations because determination of locations by coordinates are used in the most popular travel guides such as ADC maps that are available to public and sold in convenient stores.

Claim 1 of the '626 application corresponds to claim 1 of the '525 patent.

Claims 2-6, 9, 12, 20-23, 25-26, 28-30 of the '626 application correspond to claim 2 of the '525 patent.

Claims 7 and 11 of the '626 application corresponds to claim 3 of the '525 patent.

Claims 8 and 10 of the '626 application corresponds to claim 4 of the '525 patent.

Claim 13 of the '626 application corresponds to claim 6 of the '525 patent.

Claim 14 of the '626 application corresponds to claim 7 of the '525 patent.

Claims 15-17 of the '626 application corresponds to claim 9 of the '525 patent.

Claims 18 and 27 of the '626 application corresponds to claim 13 of the '525 patent.

Claims 19 and 24 of the '626 application corresponds to claim 14 of the '525 patent.

Claim 31 of the '626 application corresponds to claim 15 of the '525 patent.

Claim 32 of the '626 application corresponds to claim 17 of the '525 patent.

Claims 34-40 of the '626 application corresponds to claim 18 of the '525 patent.

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Claim 41 of the '626 application corresponds to claim 19 of the '525 patent.

Claim 42 of the '626 application corresponds to claim 20 of the '525 patent.

Claim 43 of the '626 application corresponds to claim 21 of the '525 patent.

Claim 44 of the '626 application corresponds to claim 23 of the '525 patent.

Claim 45 of the '626 application corresponds to claim 24 of the '525 patent.

Claim 46 of the '626 application corresponds to claim 25 of the '525 patent.

Claim 47 of the '626 application corresponds to claim 26 of the '525 patent.

Claims 48-51 of the '626 application correspond to claim 27 of the '525 patent.

Claims 52-53 of the '626 application correspond to claim 28 of the '525 patent.

Claims 54-56 of the '626 application correspond to claim 30 of the '525 patent.

Claim 57 of the '626 application corresponds to claim 34 of the '525 patent.

Claims 58-63 of the '626 application correspond to claim 35 of the '525 patent.

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 5,164,904 issued to Sumner

U. S. Patent No. 6,282,489 B1 issued to Bellesfield et al.

European Patent Application 0 508 787 A2 published on October 14, 1992, Nobe  
et al.

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***Point of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosain T Alam whose telephone number is (703) 308-6662. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 3800.

Additional Telephone Number for Contact are:

|                                  |              |
|----------------------------------|--------------|
| TC 2100- After Finals number is  | 703-746-7238 |
| TC 2100 Official Fax number is   | 703-746-7239 |
| TC 2100- Customer Service Center | 703-746-7240 |



Hosain T. Alam  
Primary Examiner  
Art Unit 2172

October 19, 2001